

### REMARKS

The applicant has carefully considered the Office action dated October 8, 2008, and the references it cites. By way of this response, claims 1 and 14 have been amended. Claims 15 and 16 have been added. No new matter has been introduced. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. Patent 5,954,731) in view of Hassler (U.S. Patent 5,374,277). The applicant respectfully disagrees.

Independent claim 1 is directed to a surgical instrument that includes, *inter alia*, an instrument handle having a front end and a rear end, a tube shaft having a proximal end portion and a distal end portion, wherein the proximal end portion is linked to the rear end of the instrument handle, and an instrument head, wherein the instrument head is linked to the distal end portion, and wherein the instrument handle includes a first manipulator having the shape of a rotary knob and being rotatably supported at the front end of the instrument handle. Independent claim 14 includes similar recitations.

The Office admits that Yoon fails to describe a rotary knob being rotatably supported on the handle member. *See* present action at page 3. Therefore, Yoon fails to describe a rotary knob and being rotatably supported at the front end of the instrument handle.

Similarly, Hassler also fails to describe a rotary knob and being rotatably

supported at the front end of the instrument handle. The knobs 260, 270 and 290 of Hassler are clearly shown in FIG. 1 as located at the rear end of the handle 360, the opposite of what is claimed.

As discussed above, none of the cited portions of the prior art describe a rotary knob and being rotatably supported at the front end of the instrument handle. Therefore, the combinations of Yoon and Hassler used as the bases for the obviousness rejections do not teach or suggest all of the recitations of the claims. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. “All of the words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Consequently, the obviousness rejection for all outstanding claims cannot stand and the claims are in condition for allowance.

With respect to the dependent claims, including new claims 15 and 16, these claims are allowable for at least the reasons detailed above. Furthermore, the applicant notes that the present action fails to detail where the prior art describes each element of every dependent claim. The Office is respectfully requested to comply with 37 C.F.R. 1.104 and detail where each element of every claim is found in the prior art, else the claims should be allowed.

Based on the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

**U.S. App. Serial No. 10/815,395**  
**Response to Office Action Dated October 8, 2008**

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. Please refund any overpayment to Hanley, Flight & Zimmerman, LLC at the address below.

Respectfully submitted,

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